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REMARKS

Claims 9, 10, 21, 22, 33, 34, 45, and 46 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regard as the invention. The Office Action however does not notify the Applicant of the reasons for the rejections in compliance with 35 U.S.C. § 132. Applicant respectfully points out that Applicant's claims are sufficiently definite to apprise one of ordinary skill in the art of the scope of the claims as required under 35 U.S.C. § 112, second paragraph. Claims 9, 10, 21, 22, 33, 34, 45, and 46 are therefore patentable and should be allowed. Applicant respectfully traverses each rejection individually and requests reconsideration of claims 9, 10, 21, 22, 33, 34, 45, and 46.

Claims 1-50 stand rejected under 35 U.S.C § 103(a) as unpatentable over Butler (U.S. Patent No. 6,584,493 B1) in view of Skinner, *et al.* (U.S. Patent No. 6,721,740 B1). Applicant respectfully traverses each rejection. The proposed combination of Butler in view of Skinner cannot establish a prima facie case of obviousness because the proposed combination does not teach or suggest each and every element of the claims of the present application, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination. Claims 1-50 are therefore patentable and should be allowed. Applicant respectfully traverses each rejection individually and request reconsideration of claims 1-50.

Claim Rejections – 35 U.S.C. § 112, 2nd Paragraph

Claims 9, 10, 21, 22, 33, 34, 45, and 46 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regard as the invention. Paragraph 1 of the Office Action states:

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In particular, Examiner finds the wording "in near real time" to be
indefinite. Proper amendment of the same is required. For purposes of
Examination, "in near real time" will be interpreted to mean
"immediately".

The Office Action's finding of "the wording 'in near real time' to be indefinite"
does not give the Applicant adequate notification of the reasons for the rejection.
35 U.S.C. § 132 requires the Office Action to provide notice to the Applicant of
the reasons for a rejection, including "such information and references as may be
useful in judging of the propriety of continuing the prosecution...." The *Manual
of Patent Examining Procedure* § 2173.02 provides further guidance regarding a
rejection under 35 U.S.C. § 112, second paragraph, stating that "an analysis as to
why the phrase(s) used in the claim is 'vague and indefinite' should be included in
the Office action." In this Office Action, the finding of "the wording 'in near real
time' to be indefinite" is accompanied by no explanation whatsoever to Applicant
why the phrase "in near real time" is indefinite. Without knowing any reason for
the rejection, the Applicant cannot understand the basis for the rejection. The
rejection therefore fails to meet the requirements of 35 U.S.C. § 132 and should
be withdrawn.

Because the Office Action does not comport with 35 U.S.C. § 132 to give enough
information for the Applicant to fashion a response to the Office Action, Applicant are
under no obligation to respond further. Nevertheless, in an effort to move the case
forward, Applicant will attempt to provide meaningful comment regarding the phrase
"near real time" mentioned in paragraph 1 of the Office Action. MPEP § 2173.02 sets
forth the standard for compliance with 35 U.S.C. § 112 stating that "...the examiner must
consider the claim as a whole to determine whether the claim apprises one of ordinary
skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C.
112, second paragraph, by providing clear warning to others as to what constitutes
infringement of the patent." MPEP § 2173 further explains, "Definiteness of claim
language must be analyzed, not in a vacuum, but in light of: (A) The content of the

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particular application disclosure; (B) The teaching of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made."

The phrase "near real time" specifically mentioned in paragraph 1 of the Office Action does in fact properly satisfy the definiteness requirement of 35 U.S.C. § 112, second paragraph, when analyzed in light of the factors from MPEP § 2173 above, including the Applicant's disclosure. Applicant has provided a 50 page specification including 6 pages of Figures to aid those skilled in the art in understanding Applicant claims. Moreover, Applicant has provided a definition of "near real time" at page 21, lines 25-27, of the specification stating:

> In this specification, the term "near real time" means that an event occurs
> promptly, or almost immediately, from the perspective of a human being.

In view of Applicant's specification, the phrase "near real time" is sufficiently definite to apprise one of ordinary skill in the art of its scope as required by 35 U.S.C. § 112, second paragraph. The Applicant therefore traverses the rejections individually to claims 9, 10, 21, 22, 33, 34, 45, and 46 under 35 U.S.C. § 112, second paragraph, and respectfully request the withdrawal of the rejections.

Claim Rejections - 35 U.S.C. § 103

Claims 1-50 stand rejected under 35 U.S.C § 103(a) as unpatentable over Butler (U.S. Patent No. 6,584,493 B1) in view of Skinner, *et al.* (U.S. Patent No. 6,721,740 B1). Applicant respectfully traverses each rejection. To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a

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reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicant's claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

<div align="center">Butler in view of Skinner</div>

Butler at column 1, lines 10-16, generally discloses a multiparty conferencing and collaboration tool utilizing a per-host model command, control, and communication structure which also provides pre-meeting establishment and post-meeting maintenance of application sharing by a single user. Skinner at column 3, lines 55-56, generally discloses a method and apparatus of performing active update notification. The proposed combination of Butler in view of Skinner cannot establish a prima facie case of obviousness because the proposed combination does not teach or suggest each and every element of the claims of the present application, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

<div align="center">The Combination Of Butler in view of Skinner
Does Not Teach Or Suggest All Of Applicant's Claim Limitations</div>

Regarding independent claims 1, 13, 25, and 37, the Office Action states that Figures 2A-2C of Butler teach "each user has a client device...." What Figures 2A-2C of Butler actually teach according to column 23, lines 63-66, of Butler and column 24, lines 18-19, of Butler is an illustration of how the Butler "invention allocates system resources dynamically as the members require them, and then frees up those resources when they are no longer needed." That is, Figures 2A-2C of Butler teach dynamic memory allocation among members in a multiparty conferencing and collaboration system. Nowhere in Figures 2A-2C does Butler teach or suggest "each user has a client

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device...." Butler's illustration of dynamic resource allocation is not "each user has a client device..." as claimed in the present application.

The Office Action further states regarding claims 1, 13, 25, and 37 that column 5, lines 39-49, of Butler teach "receiving from client devices digital asset records representing digital assets...." What column 5, lines 39-49, of Butler actually teaches is "a new collaboration/control model for the application sharing protocol T.128...." Butler's new collaboration/control model for the application sharing protocol T.128 concerns when and to whom relinquishment of shared application control occurs. Butler at column 5, lines 39-49, does not mention receiving from client devices digital asset records representing digital assets. Butler's new collaboration/control model for the application sharing protocol T.128 is not receiving from client devices digital asset records representing digital assets as claimed in the present application.

Further regarding claims 1, 13, 25, and 37, the Office Action states that Figure 1 of Butler, column 8, lines 48-50, of Butler and column 10, lines 5-45, of Butler teach "displaying the retrieved digital assets...." What Figure 1 and column 8, lines 48-50, actually disclose is a "monitor 47 or other type of display device...." What column 10, lines 5-45, of Butler actually disclose is a series of recommendations for "Data protocols for multimedia conferencing...." Neither the monitor in Figure 1 and described in column 8, lines 48-50, of Butler nor the series of recommendations for multimedia conferencing protocols described in column 10, lines 5-45, of Butler mention "displaying the retrieved digital assets...." as claimed here. Butler's monitor and series of recommendations for multimedia conferencing protocols are not displaying the retrieved digital assets as claimed in the present application.

The Office Action states that column 5, lines 39-49, of Butler and column 10, lines 5-45, of Butler teaches "editing one or more of the retrieved digital assets...." What column 5, lines 39-49, of Butler actually teaches is "a new collaboration/control model for the application sharing protocol T.128...." What column 10, lines 5-45, of Butler actually disclose is a series of recommendations for "Data protocols for multimedia

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conferencing...." Neither the new collaboration/control model for the application sharing protocol T.128 at column 5, lines 39-49, of Butler nor the series of recommendations for multimedia conferencing protocols described in column 10, lines 5-45, of Butler mentions "editing one or more of the retrieved digital assets...." as claimed in the present application.

In fact, a text search of Butler shows that Butler never even once mentions the words "edit" or "editing" in the entire reference. To compensate for the lack of "editing" in Butler, the Office Action states parenthetically that "a collaboration process obviously includes some form of editing functionality." The Office Action, however, provides no basis for the assertion that the collaboration of Butler includes editing as claimed in the present application. Without an explanation of how collaboration includes editing, the Office Action does not comply with 35 U.S.C. § 132 which requires the Examiner to notify the Applicant of the reasons for a rejection, including "such information and references as may be useful in judging of the propriety of continuing the prosecution...." Even if the Office Action did comply with 35 U.S.C. § 132, however, the current references to Butler would still not disclose "editing one or more of the retrieved digital assets...." Butler's new collaboration/control model for the application sharing protocol T.128 and series of recommendations for multimedia conferencing protocols are not editing one or more of the retrieved digital assets as claimed in the present application.

Regarding independent claims 1, 13, 25, and 37, the Office Action at paragraph 6, states that column 16, lines 66-67, of Skinner, column 17, lines 1-28, of Skinner, and column 18, lines 45-48, of Skinner teach the following limitations from claims 1, 13, 25, and 37:

- creating at least one user record representing a user granted access to digital assets
- each user record comprises a user access privilege field identifying for each user that user's user access privilege for access to digital assets
- at least one asset access permission field identifying a digital asset's asset access permission
- a location field identifying the location of a digital asset

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- retrieving digital assets in dependence upon the location fields in the digital asset records

- wherein the editing is carried out in dependence upon user access privilege and independence upon asset access permission

What column 16, lines 66-67, and column 17, lines 1-28, of Skinner actually disclose is a general "permissions model for determining access permissions and change permissions for different clients or users." What column 18, lines 45-48, of Skinner actually discloses is that a "database server 311 may comprise a flat-file data management system, a relational database management system (RDBMS), and object-oriented database management system (ODBMS)...." Skinner therefore merely discloses the idea of a database with access permissions. Skinner does not disclose the variety of claim limitations included in independent claims 1, 13, 25, and 37. In fact, a text search of Skinner shows that Skinner never once mentions many of the limitations cited in the Office Action. For example, "user record," "location," "location field," "digital assets," "user access," "privilege field," "edit," and "editing" occur no where in the Skinner reference. To satisfy the prima facie case for obviousness, the Office Action must cite a combination of references that teaches all the Applicant's claim limitations. Skinner's general disclosure of a database with access permission, therefore, is not the following claim limitations as claimed in the present application:

- creating at least one user record representing a user granted access to digital assets
- each user record comprises a user access privilege field identifying for each user that user's user access privilege for access to digital assets
- at least one asset access permission field identifying a digital asset's asset access permission
- a location field identifying the location of a digital asset
- retrieving digital assets in dependence upon the location fields in the digital asset records
- wherein the editing is carried out in dependence upon user access privilege and independence upon asset access permission

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Because the Office Action does not teach or suggest all the limitations of Applicant's claims, the requirements for a prima facie case of obviousness under 35 U.S.C. § 103(a) cannot be satisfied. Applicant respectfully traverses the rejection to independent claims 1, 13, 25, and 37 and request withdrawal of the rejections.

No Suggestion or Motivation to Combine Butler and Skinner

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Butler and Skinner. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine Butler and Skinner must come from the teaching of either Butler or Skinner themselves, and the Examiner must explicitly point to the teaching within Butler or Skinner suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicant's own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action asserts a rationale for motivation to combine Butler and Skinner at paragraph 7 stating:

> It would have been obvious to one having ordinary skill in the art at the
> time the invention by Applicant to incorporate the permission and
> database functionalities of Skinner within the Butler structure as noted
> within Skinner which teaches enterprise applications....

In support of the Office Action's assertion that combining Butler and Skinner would have been obvious to one skilled in the art, the Office Action cites column 1, lines 47-64, of Skinner. What column 1, lines 47-64, of Skinner actually discloses is the desirability

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"that the effects of other users' modifications, as well as those modifications performed by the application itself (e.g., time-based changes), be made evident to each user in near real time." Skinner's specification further explains how the invention of Skinner satisfies this need by generally disclosing a method and apparatus of performing active update notification at column 3, lines 55-56 of Skinner. At no place cited in the Office Action does Skinner suggest a rationale to combine Skinner's method and apparatus of performing active update notification with Butler's multiparty conferencing and collaboration tool utilizing a per-host model command, control, and communication structure. In fact, Butler and Skinner disclose very different inventions. The abstract of Butler indicates that the multiparty conferencing and collaboration tool utilizing a per-host model is concerned with reducing network traffic, allowing greater scalability through dynamic system resource allocation, and allowing a single host to establish and maintain a share session with no other members present as indicated in the abstract. The abstract of Skinner indicates that the method and apparatus of performing active update notification however is concerned with maintaining a registry of interest objects to determine which clients or servers may be interested in changes to data objects. Skinner at column 1, lines 47-64, as cited in the Office Action does not support the combination of the dissimilar disclosures of Butler and Skinner.

The references cited in the Office Action do not support the assertion that one skilled in the art would have been motivated to combine Butler and Skinner. Absent a showing from the references of a motivation to combine, the Office Action impermissibly displays hindsight occasioned by Applicant's own teaching to reject the claims. As such, the proposed combination of Butler and Skinner cannot establish a prima facie case of obviousness.

<u>No Reasonable Expectation of Success in the
Proposed Combination of Butler and Skinner</u>

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Butler and Skinner. *In re Merck & Co., Inc.*, 800

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F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The teachings of Butler and Skinner are not sufficient to render the claims prima facie obvious if the proposed combination of Butler and Skinner would change the principle of operation of either Butler or Skinner. *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349 (CCPA 1959).

There can be no reasonable expectation of success in a proposed combination of Butler's multiparty conferencing and collaboration tool utilizing a per-host model command, control, and communication structure with Skinner's method and apparatus of performing active update notification to produce ad hoc data sharing in virtual team rooms as claimed in the present application. On the contrary, Butler's multiparty conferencing and collaboration tool utilizing a per-host model command, control, and communication structure would clearly change the principle of Skinner's method and apparatus of performing active update notification. Butler beginning at column 1, line 43, clearly characterizes the principle operation of the invention stating:

> By implementing the per-host model whereby communication with and control of the host takes place in a private fashion between the host and a remote with periodic broadcast updates by the host to the entire share group, the total number of network messages which are required to be transmitted between the members of the share group are greatly reduced.

Skinner beginning at column 3, line 7, clearly indicates the principle operation of the invention for a method of performing active update notification stating, "Update notifications are then sent only to the interested clients or servers." The principle of operation of Butler, providing private communication between the host and the remote with periodic broadcast updates by the host to the entire group, is changed completely, and in fact will not function at all, with the addition of Skinner's update notifications that are only sent to interested clients or servers. The proposed combination of Butler and Skinner therefore cannot possibly support a prima facie case of obviousness.

Butler combined with Skinner does not disclose each and every element of independent claims 1, 13, 25, and 37. There is no suggestion to combine Butler and Skinner in either reference, and there is no reasonable expectation of success in the proposed combination. The Office Action therefore does not establish a prima facie case of obviousness under 35 U.S.C. § 103. Applicant respectfully traverses the rejection to claims 1, 13, 25, and 37 and requests that claims 1, 13, 25, and 37 be allowed.

Relations Among Claims

Claims 2-12, 14-24, 26-36, and 38-50 depend respectively from independent claims 1, 13, 25, and 37. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Butler and Skinner does not teach or suggest each and every element of the independent claims and no other references refer to the elements of the independent claims, no proposed combination of references can possibly teach or suggest each and every element of any dependent claim. The rejections of dependent claims 2-12, 14-24, 26-36, and 38-50 therefore should be withdrawn, and these claims also should be allowed.

Conclusion

Claims 9, 10, 21, 22, 33, 34, 45, and 46 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regard as the invention. The Office Action however does not notify the Applicant of the reasons for the rejections in compliance with 35 U.S.C. § 132. Applicant respectfully points out that Applicant's claims are sufficiently definite to apprise one of ordinary skill in the art of the scope of the claims as required under 35 U.S.C. § 112, second paragraph. Claims 9, 10, 21, 22, 33, 34, 45, and 46 are therefore patentable and should be allowed. Applicant respectfully traverses each rejection individually and requests reconsideration of claims 9, 10, 21, 22, 33, 34, 45, and 46.

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Claims 1-50 stand rejected under 35 U.S.C § 103(a) as unpatentable over Butler (U.S.
Patent No. 6,584,493 B1) in view of Skinner, *et al.* (U.S. Patent No. 6,721,740 B1).
Applicant respectfully traverses each rejection. The proposed combination of Butler in
view of Skinner cannot establish a prima facie case of obviousness because the proposed
combination does not teach or suggest each and every element of the claims of the
present application, there is no suggestion or motivation to make the proposed
combination, and there is no reasonable expectation of success in the proposed
combination. Claims 1-50 are therefore patentable and should be allowed. Applicant
respectfully traverses each rejection individually and requests reconsideration of claims
1-50.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447
for any fees required or overpaid.

Respectfully submitted,

Date:__July 25, 2005_____   By: _____

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